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TOWNSEND & BANTA

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EXAMINER

KAROL, JODY LYNN

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

This action is in response the Amendment after Final and the Arguments/Remarks made in an Amendment filed 5/22/2008. Claims 3, 5, and 7 have been cancelled, and claim 1 has been amended.

Response to Arguments

1. The rejections of claims 3, 5, and 7 are withdrawn in view of Applicants' cancellation of these claims.
2. Applicant's arguments in regards to the rejection of claims 1-2, 4, and 6 on the ground of non-statutory obviousness-type double patenting over claims 1, 5, 7, 11 and 16 of copending Application No. 09/936317 in view of Sato et al. (JP 2000-219609 A) have been fully considered but have not been found persuasive. Application 09/936,317 is still considered pending by the USPTO, and thus the rejection is maintained for the reasons of record.
3. Applicants' request for reconsideration of the rejection of claims 1-2, 4, and 6 under 35 U.S.C. 103(a) as being unpatentable over Delrieu et al. (US 5,961,990) in view of Sato et al. (JP 2000-219609 A), in view of the amendment to claim 1 have been fully considered but were not found persuasive.

Applicants argue that claim 1, as amended, excludes a restraining polymer and active agent from being present in the microgel. However, for the purposes of

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searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., *PPG*, 156 F.3d at 1355, 48 USPQ2d at 1355. Furthermore, *Delrieu et al.* teaches that the restraining polymer binds the active agent (see column 4 lines 10-16), and that restraining polymer is water-soluble, and dissolved in water mixed with agar to form the agar gel (see column 4, lines 27-30, 62-67). Thus, the restraining polymer with the bound active agent is broadly interpreted as an "aqueous component" as recited in the amended claim 1, because it is soluble in water.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, *Delrieu et al.* clearly teaches the agar gel particles can be incorporated into cosmetic formulations, and that cosmetic formulations include water-in-oil emulsions (see column 11, line 63 to column 12, line 24). *Sato et al.* teaches water-in-oil emulsified compositions, thus there is motivation to combine the references.